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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,474	05/26/2000	Charles Philippe Tresser	YO999-486	9995
48150	7590	12/12/2005	EXAMINER	
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			ELISCA, PIERRE E	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/578,474	Applicant(s) TRESSER, CHARLES PHILIPPE	
	Examiner Pierre E. Elisca	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 33-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-28 and 33 is/are allowed.
- 6) ☒ Claim(s) 1-5, 14-23 and 34-50 is/are rejected.
- 7) ☒ Claim(s) 6-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is in response to Applicant's response filed on 10/05/2005.
2. Claims 1-28 and 33-46 are pending. Claims 29-32 are cancelled.

Claim Objections

3. Claims 6-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowable Subject Matter

4. Claims 24-28 and 33 are allowed over the prior art.
5. The rejection to claims 1-5, 14-18, 19-23, and 34-46 under 35 U.S.C. 103 (a) as being unpatentable over Muto in view of Asad, and to claims 1-5, 14-23 and 34-46 over Okumura et al (JP 10-021302) in view of Ensor et al. (U.S. Pat. No. 5,721,780) as set forth in the office action mailed on 7/12/2005 is maintained.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 14-18, 19-23, 34-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muto Akihiro JP 10-074221 in view of Ohta et al (U.S. Pat. No. 5,991,623).

As per claims 1, 2, 3, 5, 14-23, 34-40 Muto substantially discloses an information mediating device capable of protecting user's privacy against an information receiving side and guaranteeing the reliability of information communication by preventing information or attribute data specified by a user from being disclosed to the information receiving side which is readable as Applicant's claimed invention wherein said a method of using a personal device in conducting transactions over a network such that Applicant's third party reads on element 2, Applicant's first party reads on the customer, element 1, Applicant's second party reads on a merchant, element 3, and Applicant's step of providing the second party with information identifying said first party only as a transactional party in said electronic business transaction reads on the authorization given to the merchant by the settlement bank, element 2. Applicant's proprietary item reads on the portable device, element 1, and Applicant's information identifying the customer reads on the authorization code generated by the portable device, element 1. Please note that the step of conducting the electronic business transaction between said first and second parties through the third party such that said identity of said first party is kept from the second party (see., abstract, specifically wherein said mediating device 2 is used for a computer network such as interconnection network and provided

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with a function capable of securing especially the anonymity of an information transmitting side.

Muto fails to explicitly disclose an intermediary relationship by said third party comprises replacing an identification data about said first party OR replacing a password with key identification.

Ohta discloses a method/system for preventing unjust use of personal communication terminal. A user of a contracted terminal transmits a special number for replacing the communication control information and a password by a cryptographic key (see., abstract, col 11, lines 35-55, col 12, lines 1-27). Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the commercial transaction of Muto by including the limitation detailed above as taught by Ohta because this would allow digital keys to be confirmed by the end-user or third party.

8. Claims 41, 42, and 44-46 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Muto and Henley, and further in view of Ohta.

As per claims 41, 42, and 44-46 Muto and Henley disclose the use of an information mediating device capable of protecting user's privacy against an information receiving side. Henley discloses a system (business entity), element 16, for providing medical services from a plurality of providers (verifiers), element 83, to a user, wherein the user is required to pay for (i.e., insurance or out-of-pocket) the services and hence, must authenticate himself to the provider. It is considered that it would have been obvious to

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a person of ordinary skill in the art at the time the invention was made to modify Muto to include the specifics of the provider selection arrangement of Henley and use the device of Muto for purposes of user authentication to the providers as user authentication is old and well-known to be a requirement of any type of business transaction. Although neither Muto nor Henley specifically disclose the type of encryption used for communications between the parties, it is considered to be old and well-known that a customer will have software that will enable him to encrypt any private information (application) using the public key of the recipient (business entity) as is done using public key encryption (public signature scheme). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combined teachings of Muto and Henley to include public key encryption for the purpose of encrypting the information passed between the parties as a matter of design choice.

Muto fails to explicitly disclose an intermediary relationship by said third party comprises replacing an identification data about said first party OR replacing a password with key identification.

Ohta discloses a method/system for preventing unjust use of personal communication terminal. A user of a contracted terminal transmits a special number for replacing the communication control information and a password by a cryptographic key (see., abstract, col 11, lines 35-55, col 12, lines 1-27). Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the commercial transaction of Muto by including the limitation detailed above as

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taught by Ohta because this would allow digital keys to be confirmed by the end-user or third party.

9. Claims 1-5, 14-23 and 34-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okumura et al (JP 10-021302) in view of Ensor et al. (U.S. Pat. No. 5,721,780).

As per claims 1-5, 14-23 and 34-46 Okumura substantially discloses a service provider L, a service utilizer I and an information manager C for storing the attribute information bi of the user I. The provider L decodes the received data twici and acquires the service utilizing information ai and the attribute information bi while guaranteeing the anonymity of the user I which is readable as Applicant's claimed invention wherein said a method of using a personal device in conducting transactions over a network such that Applicant's third party reads on fig 1, Applicant's first party reads on the customer, fig 1, Applicant's second party reads on a merchant, fig 1, and Applicant's step of providing the second party with information identifying said first party only as a transactional party in said electronic business transaction reads on the authorization given to the merchant by the settlement bank, fig 1. Applicant's proprietary item reads on the portable device, fig 1, and Applicant's information identifying the customer reads on the authorization code generated by the portable device, fig 1. Please note that the step of conducting the electronic business transaction between said first and second parties through the third party such that said identity of said first party is kept from the second party (see., abstract).

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Okumura fails to explicitly disclose an intermediary relationship by said third party comprises replacing an identification data about said first party OR replacing a password with key identification.

Ensor discloses a password authentication security system for a telecommunications network having a network control center for replacing the original password to an encryption key (see., col 6, lines 26-45). Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the information collecting system of Okumura by including the limitation detailed above as taught by Ensor because this would allow digital keys to be confirmed by the end-user or third party.

RESPONSE TO ARGUMENTS

10. Applicant's arguments filed on 07/12/2005 have been fully considered but they are moot in view of new ground (s).

REMARKS

11. In response to Applicant's arguments, Applicant argues that:

a. "Okumura would not have been combined with Ensor to form the invention of claims 1-5, 14-23 and 34-46". The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one

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of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter.); and *Es parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to *Ex parte Levengood*, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. *In re Soli*, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

b. " replacing an identification data about said first party or replacing a password with key identification". As discussed above, Okumura fails to explicitly disclose an

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intermediary relationship by said third party comprises replacing an identification data about said first party OR replacing a password with key identification.

Ensor discloses a password authentication security system for a telecommunications network having a network control center for replacing the original password to an encryption key (see., col 6, lines 26-45). Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the information collecting system of Okumura by including the limitation detailed above as taught by Ensor because this would allow digital keys to be confirmed by the end-user or third party.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571 272 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

December 07, 2005